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Paper No. 14

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OFFICE OF PETITIONS

In re Patent No. 6,179,736 :
Issued: 01/30/2001 :
Application No. 09/227,139 :
Filed: 01/07/1999 :
For: GRAPHITE ARROW AND METHOD:
OF MANUFACTURE :

ON PETITION

This is in response to the petition filed October 15, 2010, which is being treated under 37 CFR 1.378(b), to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. 37 CFR 1.378(a).

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The present petition lacks items (1), (2) and (3).

The USPTO finance record reveals that the 3.5 year maintenance fee of \$450.00 submitted on January 28, 2005, was refunded by treasury check on October 6, 2006. The Office has no record of receiving payment of the 7.5 year maintenance fee. Furthermore, petitioner did not submit the 3.5 year and the 7.5 year maintenance fees and the required surcharge under 37 CFR 1.20(i)(1) with the present petition. The Office notes that the maintenance fees, as well as the required surcharge, must be paid as a condition for accepting the late maintenance fee on petition. The Office further notes that petitioner failed to sign page 3 of 4 of the present petition.

In view of the above, the Office is unable to treat the present petition on the merits until petitioner submits a "renewed" petition under 37 CFR 1.378(b), the payment for the surcharge after expiration (currently \$700.00), the maintenance fees due at 3.5 and 7.5 years (\$490.00 and \$1,240.00 respectively) **as well as documentary evidence in support of a showing of unavoidable delay.** Thus, the petition is dismissed. The Office reminds petitioner that the surcharge after expiration must be paid in the amount due on the date the "renewed" petition is filed.

Although the Office will not address the petition on its merits, the Office reminds petitioner that in determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). At the time of the expiration of a patent, it is the patent owners who are ultimately the persons responsible to ensure the timely payment of the maintenance fees. The patent owners may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owners from their obligation to take appropriate steps to ensure the timely payment of such maintenance fees. The Office further reminds petitioner that under the statutes and regulations, the USPTO has no duty to notify a patent owner of the requirement to pay maintenance fees or to notify the patentee when the maintenance fee is due. The Office may mail a maintenance fee reminder strictly as a courtesy; however, it is solely the responsibility of the patent owner to ensure that the maintenance fee is paid timely to prevent expiration of the patent. The failure to receive a maintenance fee reminder does not relieve the patentee of the obligation to timely pay the maintenance fee, nor will it constitute unavoidable delay if the patentee seeks reinstatement under the regulation. Rydeen v. Quigg, 748 F. Supp. 900, 905 (D.D.C. 1990).

The required showing for unavoidable delay must set forth the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which petitioner became aware of the expiration of the patent, and the steps taken to file the petition promptly. MPEP 2590. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Id. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. Thus, where a patentee fails to show that he took reasonable steps, or discloses that he took no steps to ensure

timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
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By FAX: (571) 273-8300
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The patent file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

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Enclosure: Form PTO/SB/65